

## REMARKS

Claims 27 and 28 have been cancelled and new Claim 29 is submitted. A brief review of Claim 29 will illustrate the structural and functional distinctions between the claimed subject matter and the prior art relied upon by the Examiner. The first element of the claim recites a paint brush and of course there is no paint brush in any of the novelty candy prior art references cited by the Examiner. The Examiner states that the claimed product "only differs from the prior art product in the shape". Except for the word "only" which is apparently intended to trivialize the invention compared to the prior art, in order to reach the conclusion of obviousness to one skilled in the art, this statement is not the law. It is evident that shape of a product may affect function and distinguish prior art. For example, an airplane wing airfoil shape may affect the functional aerodynamic characteristics of the wing and may be patentable if it differs from the prior art. As set forth in the Moskowitz declaration the paint brush shape does indeed have advantages over the paint roller sucker of the prior art.

Similarly, the Examiner states that the prior art Paint Pop reference showing a paint tray and roller with a separate packet of powder is a conventional shape as is a paint brush and can. But so characterizing the prior art product and the subject matter of the claim, including the paint brush, does not support an obviousness rejection. It is noted that the Examiner did not base its rejection on Section 102 for anticipation. Applicant assumes that the reason is the clear distinction in shape and function between the claimed subject matter and the prior art Paint Pop. Nowhere does the Examiner point to anything

within the Paint Pop reference that suggests the substitution of a paint roller with an entirely different configuration and function, such as the claimed paint brush. Yet the Examiner appears to suggest that because a candy paint brush and can on the one hand, and a candy paint tray and roller on the other, are "conventional shapes", it would be obvious for one aware of the simulated paint tray and roller novelty candy product to simulate a paint can and brush. As previously argued, and for which the Examiner offered no response, the mere fact that both products are candy simulations of actual products used in house painting does not establish that the claimed subject matter is obvious except by use of pure hindsight. There are many ways of applying paint including paint sprayers and an artist's pallet and brush. The Examiner offers no reason as to why it would be obvious to choose the simulated can and brush as opposed to simulated other painting equipment to create a confectionery product. There is no logic in the suggestion that because two candy novelties simulate actual devices used in the same field it would be obvious to substitute one for another. With respect to the paint brush element, the Examiner could just as well rely upon an actual paint brush and argue that the existence of a functional paint brush meets the paint brush element of the claim. Clearly, the Examiner recognizes that a real paint brush is not the same as a candy paint brush for reason too obvious to mention. If a sucker (hard candy) is in the shape of a paint roller, as a simulation of an actual functional product, why would one of ordinary skill in the art substitute a candy paint brush for the candy paint roller. There is simply no basis for that substitution other than hindsight based on the claimed subject matter.

The second element of the claim clearly recites a container as well as means on the container for engaging a lid. Again the Examiner is apparently analogizing between the claimed can and the prior art paint tray. For the reasons set forth above, the fact that both candy products are simulations of implements from a similar functional group is not a basis for an obviousness rejection. The Examiner's argument is even weaker here compared to the brush-roller, since the Examiner recognizes that the claim clearly recites a lid that cooperates with the can so as to enclose its contents whereas no lid is shown in the Paint Pop product. This has forced the Examiner to go to a product that is not candy, but a functional paint tray that has a lid as in Gramlich and Kern. Where is the suggestion in the Paint Pop product that the tray should be provided with a lid. As set forth below, in the declaration of the developer of the paint tray product, Mr. Moskowitz, it certainly did not occur to him to add a lid to the candy paint tray because there was no recognition of the problem that the lid solved. It is true that the lid in the actual paint tray prior art references keep the paint from spilling when all of the paint has not been used and the painting operation has been temporarily suspended. But as previously pointed out, that is only one function of the lid applied to the can in Applicant's claimed subject matter. More importantly, as previously pointed out, the utility of the lid in the claimed combination (in addition to preventing spilling of unused powder) is that the powder may be contained in the lid-enclosed container at the time of sale. This limitation to the claim is incorporated in Element 4. It is submitted that there simply is no suggestion in the Paint Pop product for the addition of a lid as in the Gramlich and Kern functional paint trays.

The comment with respect to Element 2 regarding the lid are equally applicable to Element 3. Again, there is simply no suggestion for placing a lid on the Paint Pop novelty candy product.

Element 4 is obviously distinct from the powdered candy in the Paint Pop reference because it specifically recites that the powdered candy is contained in the container with the lid closed at the time of sale whereas in the Paint Pop product, the powdered candy is contained in a separate packet at the time of sale. Again there is no suggestion in the Paint Pop product that the powdered candy could be contained in the paint tray at the time of sale. That is more emphatically true when it is considered that the Paint Pop product does not disclose a lid and the Examiner must find a lid in an actual paint tray product to combine with the paint tray in the Paint Pop product which is without any suggestion. And the functional difference has been pointed out previously. It is both cheaper and more hygienic to sell the product with the flowable confectionery contained in a can with a removable lid than it is to place the flowable confectionery in a separate packet, which must be ripped open and poured into the paint tray.

In Element 5, there is simply nothing shown in the prior art that discloses a holder for a paint brush which is attached to the container. Indeed there is no "holder" in the Paint Pop product nor in the Gramlich and Kern references. And thus there is no holder that is attached to the container (presumably the paint tray in the Examiner's argument) either. Thus this element is entirely unmet by any prior art relied upon by the Examiner.

In summary, it is clear that what the Examiner has done is to entirely construct a new product based upon the teachings of Applicant. The Examiner cannot point to any

suggestion in the Paint Pop product for a paint brush, a paint can, a lid on the paint can, a flowable confectionery within the can at the time of sale, and a paint brush holder. Moreover, the Examiner is in error in arguing that candy novelty products that simulate actual functional products would be obvious to one having ordinary skill in the art even though the two candy products are entirely different in structure and function merely because the candy products simulate actual products having the same ultimate uses. It is respectfully submitted that the Examiner should withdraw the rejection based on 35 U.S.C. § 103.

In addition to the above analysis, Applicant submits that secondary considerations including commercial success and industry recognition further demonstrate the non-obviousness of the claimed subject matter.

The Examiner noted that at the December 19, 2001 interview including the inventor, Mr. Brad Baker, a declaration was shown to the Examiner stating that the invention enjoyed commercial success and also mentioning that the product had received the Professional Candy Buyer's Product of the Year Award. The examiner then states:

There is no evidence in the declaration to show commercial success. The single sales figure without any comparative date and other evidence is not found convincing and proving commercial success.

In view of the examiner's comment, applicant submits additional evidence with respect to commercial success. First, applicant has restated the Declaration of Brad Baker, the inventor. Mr. Baker sets forth in greater detail his experience and knowledge of the industry so as to lay the foundation for his statements regarding commercial success. Mr. Baker then states that in three years product sales have been approximately \$50 million

which is the most successful product of Impact in its history. That should provide the Examiner with some comparative data that supports Mr. Baker's conclusion. Mr. Baker further states that compared to other Impact products, in his opinion, Paint Shop is a commercial success. Mr. Baker then goes on to state that he is aware of the competitive position of Impact including its products in the segment of the candy market in which Impact participates. Based on his industry knowledge he then opines that Paint Shop is a highly successful product compared to the products of other companies, i.e. competitive products. This provides the Examiner with additional comparative data supporting the conclusion of commercial success.

In a product such as a confectionery set that sells to children, success of the product is attributable to how well it appeals to the purchaser. In no other type of product that comes to mind is the appeal defined by the novelty or uniqueness of the product since this is the driving force for purchases of these types of products. Uniqueness for uniqueness sake. Different for the sake of being different. That is the appeal of the product for a child. And from the point of view of the parent who is more likely to purchase or authorize purchase of the product, applicant has already pointed out the advantages of applicant's product that creates the adult demand - - non-spilling, easily consumed, hygienic, and of course easy to use. Those are the features of the invention that appeal to a parent purchasing the confectionery set and those are the features which have been embodied in Claim 29. And those features do not exist in the Roller Pop product upon which the Examiner relies for rejection.

The second declaration comes from Mr. Steven Moskowitz who is currently an employee of Impact but was previously employed by one of the largest companies in the novelty candy field, Topps, Inc. By chance, it was Mr. Moskowitz who developed the Roller Pop product on which the Examiner relies for rejection of the invention in this application. Mr. Moskowitz explains that he is familiar with both the Topps product that he developed as well as the Paint Shop product. He states that the Roller Pop product was only a mild success whereas the Paint Shop product is a commercial success. He supports that conclusion with the reasons why he believes that to be the case which are set forth in detail in paragraph 4 of the Declaration. Thus, not only does Mr. Moskowitz opine that the Paint Shop product is a commercial success but provides his reasons, based on his experience in the industry, and particularly in light of his personal experience in the development of the Roller Pop product, why the Paint Shop product is a success.

In addition, applicant submits a third declaration of Mr. Douglas E. Taylor who is a consultant in the candy industry and the President of DT & Associates, Ltd. Mr. Taylor, after providing his background in the industry to establish the foundation for his opinion bases his opinion that the Paint Shop product is a commercial success on analysis of industry data obtained from POS devices. The data, including Mr. Taylor's explanation and analysis of the data, is set forth in Paragraph 4 of his Declaration. As he there states, the data collected by IRI, an independent data collection and reporting firm, establishes the significant commercial success for the Paint Shop product in a variety of different trade channels. This objective data, coming from a professional consultant

clearly overcomes the Examiner's summary objection that the commercial success Declaration of Brad Baker submitted at the time of the oral interview is inadequate.

To the extent that the Examiner is contending that the \$50 million sales figure originally presented in the interview and confirmed in the enclosed Baker Declaration is inadequate in itself to show commercial success, it is important to note that these sales were over a period of approximately three years - - a rapid rise in sales of any product in any market. It is not merely the \$50 million but rather the rate of growth of sales that attests to the commercial success.

The Examiner also summarily dismissed the statement in the initial Declaration of Brad Baker submitted to the Examiner at the oral interview that the Paint Shop product had received an industry award. The examiner states that that does not constitute commercial success. Industry recognition however is, if not evidence of commercial success, at least evidence that professionals in the field attributed merit to the patented subject matter. Warner-Jenkinson Co. v. Allied Chem. Corp., 477 F.Supp.371, 393 (S.D. N.Y. 1979), aff'd, 633 F.2d 208 (2<sup>nd</sup> Cir. 1980) ("The compound has . . . been acclaimed by the industry, winning the Putman Food Award for its inventive contribution."); Water Technologies Corp. v. Calco Ltd., 1 U.S.P.Q.2d 1178, 1183 (N.D. Ill. 1986), on motion to amend judgment, 1 U.S.P.Q.2d 1872 (N.D. Ill. 1987), aff'd in part, rev'd in part, 850 F.2d 660 (Fed. Cir. 1988) ("[T]he inventors . . . received awards from NASA for their development of the Tri-Iodide Demand Resin which was used in the first space shuttle flight 'Columbia' in April 1981."); Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565 (Fed. Cir. 1986). It is therefore suggested that the award for the Paint Shop product

constitutes recognition of the merit of the invention in its particular field and thus further supports applicant's position that the invention was not merely a matter of selecting a conventional shape.

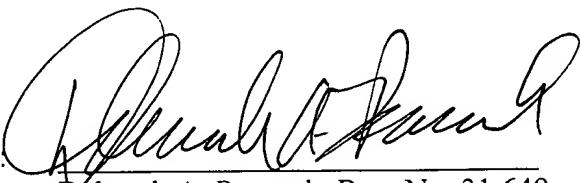
Based on the above arguments it is submitted that Claim 29 is in condition for allowance and the same is respectfully requested. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, he is cordially invited to telephone the undersigned attorney for Applicant, collect, at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached paper is captioned "Version with Markings to Show Changes Made."

Also being filed herewith is a Petition for Extension of Time to May 30, 2002, with the appropriate fee. Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Respectfully submitted,

By:   
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Dated: May 30, 2002

**Version with Markings to Show Changes Made**

**In the Claims:**

Cancel claims 27 and 28.

Please add the following new claim.

29. A confectionery set comprising  
a paint brush having a non-edible handle portion and an edible  
bristle portion;  
a container in the form of a cylindrical can with a rim surrounding  
a top opening, said rim including lid engagement means for securing a lid on said  
container so as to close the container;  
a lid having can engagement means for mating with said lid  
engagement means to form a seal between said lid and can at least at the time of sale of  
the confectionery set;  
a flowable confectionery disposed within the lid-enclosed  
container at the time of sale of the confectionery set and extractable by wetting and  
dipping said paint brush edible portion in said confectionery; and  
a paint brush holder attached to said container.